

REMARKS

Claims 5-31 are pending in the instant application, with claims 5, 14, and 29 in independent form. Independent claim 5 has been amended to further claim a step of separating the carboxylate from the hydroalkoxysilane, support for which can at least be found in paragraph [0015], lines 26-29 on page 5 of the original application as filed, as well as in Examples 1, 2, and 7. Claims 14 and 29 have been amended in a similar manner to claim 5, with claim 14 being amended to specify that the carboxylate is separated from the hydroalkoxysilane prior to use of said hydroalkoxysilane as a reagent, starting material, or additive in view of the fact that claim 14 claims the stabilized hydroalkoxysilane itself, support for which can at least be found in paragraph [0015], lines 26-29 on page 5 of the original application as filed. Claim 9 has been amended to specify that the carboxylate is present in the amounts claimed prior to separation in view of the amendments to claim 5 from which claim 9 depends. Claims 24 and 28 have been amended to specify that the carboxylate is separated through filtration. Claims 26 and 27 have been amended to properly claim a stabilized hydroalkoxysilane instead of a method. Claims 1-4 were previously cancelled. No claims are presently added, and no claims are presently cancelled. No new matter has been added through the present Amendment.

Claims 5-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Westmeyer et al. (United States Patent No. 6,365,696). The Applicants respectfully submit that, in view of the amendments to independent claims 5, 14, and 29, the obviousness rejections over Westmeyer et al. are overcome such that these rejections must be withdrawn.

The Applicants refrain from providing a lengthy recitation of the proper standards for conducting the obviousness analysis in the wake of *KSR v. Teleflex*. However, the Applicants provide the following guidelines that are particularly relevant to the instant analysis. It is well established that 35 U.S.C. §103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the **subject matter as a whole** would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” (Emphasis added) *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). When making an obviousness rejection, Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied, and it is appropriate to include explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done. See MPEP 2141(II.). In fact, as succinctly summarized in MPEP 2141(II.), the focus when making a determination of obviousness should be on what a person of ordinary skill in the pertinent art **would have known at the time of the invention, and on what such a person would have reasonably expected to have been able to do in view of that knowledge** (emphasis added).

As a primary matter, the Applicants note that the amendments to independent claims 5, 14, and 29 further define the scope of the claimed invention by specifying a discrete separation step in which the carboxylate is specifically **separated from the hydroalkoxysilane itself**. The further claimed step highlights the significant features of the instantly claimed invention, which

is the achievement of superior stabilization of hydroalkoxysilane when carboxylates are combined therewith. Because the carboxylate is specifically claimed to be separated from the hydroalkoxysilane, and **not** a reaction product of the hydroalkoxysilane, the Applicants respectfully submit that the invention as claimed in independent claims 5, 14, and 29 is both novel and non-obvious in view of the teachings of Westmeyer et al.

Although Westmeyer et al. teaches filtration of compositions within the disclosure thereof, such filtration is done **after** a hydrosilation reaction when no Si-H is left in the composition (see column 7, line 55 to column 8, line 8 of Westmeyer et al.). To explain, the Abstract of the Invention of Westmeyer et al. succinctly provides that carboxylates **must** be present during a platinum-catalyzed hydrosilation reaction of ethylenically-unsaturated epoxides and a silicon-hydride (such as a hydroalkoxysilane). Further, Westmeyer et al. makes it very clear that filtration **only** occurs after completion of the reaction (under which circumstances the carboxylates may be separated from the composition, although it is not clear from the disclosure of Westmeyer et al. if the carboxylates are separated from the composition at all). Importantly, completion of the reaction in Westmeyer et al. is signified by the absence of Si-H (which is also an indication of the absence of any unreacted hydroalkoxysilane, see column 8, lines 1 and 2 of Westmeyer et al.). As such, it is outside of the scope of the teachings of Westmeyer et al. to separate a carboxylate from a hydroalkoxysilane itself.

The Applicants further note that the carboxylates taught by Westmeyer et al. are included for purposes of stabilizing the ethylenically-unsaturated epoxides, and there is no

teachings whatsoever within Westmeyer et al. of any benefit of including the carboxylates with the hydroalkoxysilanes prior to reaction with the ethylenically-unsaturated epoxides. As such, there are clearly no teachings within Westmeyer et al. that would have directed a person of skill in the art to not only include the carboxylate with the hydroalkoxysilanes prior to reaction with the ethylenically-unsaturated epoxides, but to also **separate the carboxylates from the hydroalkoxysilanes themselves**. As such, it is clear that a person of ordinary skill in the art would not reasonably have been expected to practice the instant invention as claimed in independent claims 5, 14, and 29 in view of the teachings of Westmeyer et al.

Further, with regard to independent claim 14, in particular, the Applicants respectfully submit that separating the carboxylate from the stabilized hydroalkoxysilane prior to use of the hydroalkoxysilane as a reagent, starting material, or additive results in a hydroalkoxysilane that is distinctive from hydroalkoxysilanes of the prior art and illustrates the novelty and non-obviousness of the resulting hydroalkoxysilane itself.

In view of the remarks set forth above, the Applicants respectfully submit that independent claims 5, 14, and 29, as amended, are both novel and non-obvious over the prior art, including Westmeyer et al., such that these claims, as well as the claims that depend therefrom, are in condition for allowance.

The appropriate fee for a Request for Continued Examination is included herewith. If any additional fees are necessary to respond to the outstanding Office Action, the Commissioner

is hereby authorized to charge such fees to Deposit Account No. 08-2789, in the name of Howard & Howard, or credit the account for any overpayment.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS

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Date

/Christopher S. Andrzejak/

Christopher S. Andrzejak, Registration No. 57,212

Howard and Howard Attorneys PLLC

450 West Fourth Street

Royal Oak, MI 48067

(248) 723-0438